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09/406,320	09/27/1999	GUIDO M. SCHUSTER	99.373	1480

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EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
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2645

35

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/406,320

Applicant(s)

SCHUSTER ET AL.

Examiner

Allan Hoosain

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,14-16,18-23,41-47 and 51-57 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 54-57 is/are allowed.
- 6) ☒ Claim(s) 1,2,14-16,18-23,41-43,45-47 and 51-53 is/are rejected.
- 7) ☒ Claim(s) 3,6 and 44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **FINAL DETAILED ACTION**

### ***Allowable Subject Matter***

1. Claims 54-57 are allowed.
2. Claims 3,6, 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claims 1-2,14-16,18-23,47,51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bateman et al.** (US 5,884,032) in view of **Bannister et al.** (US 6,430,282).

As to Claims 1,14-16,18,20,22-23,47,51-53, with respect to Figures 1-2, **Bateman** teaches a system for providing HTML pages (advertising) on a data network telephony system comprising:

a data network to provide data connectivity for a plurality of data communications channels using data transport protocols (Figure 1, label 6);

a commercial message server, 28, being operable to commence a self-serve session (download at least one commercial message) (Col. 6, lines 1-10);

a first voice enabled PC and second voice enabled PC (data network telephone) connected to the data network, each data network telephone operable to communicate voice signals as data packets on a voice over data channel, the voice over data channel being one of the plurality of data communications channels on the data network containing packetized voice signals, the data network telephones identified by a caller (first) and agent (second) user identifier corresponding to the data network telephones (Figure 1 and Col. 7, lines 5-13);

a network telephony connection server, 24, being operable to provide telephony service to the data network telephones and communicate at least one HTML page (commercial message) request with the commercial message server (Col. 7, lines 1-9 and Col. 6, lines 48-60, 61-65);  
and

the first data network telephone being operable to receive the HTML page (downloaded commercial messages) before the first and second data network telephones communicate voice signals on the voice over data channel (Col. 6 lines 8-13,61-65),

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the first data network telephone further comprising a message display device to display the commercial messages (Col. 6, lines 8-13);

**Bateman** does not teach the following limitation:

“download”

**Bannister** teaches downloading HTML home pages to data terminals (Col. 7, lines 37-45). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add download capability to **Bateman's** invention for displaying home pages as taught by **Bannister's** invention in order to provide organizations assistance to callers.

As to Claim 2, **Bateman** teaches the system of Claim 1 wherein:

each user identifier that includes a unique sequence of alphanumeric elements (Col. 7, lines 9-11).

As to Claims 14-15, **Bateman** teaches the system of claim 1 wherein the network telephony connection server further comprises:

a Customer Contact Channel Changer (advertisement service) to retrieve a HTML page (at least one commercial message) from the commercial message server and to communicate the commercial messages in the response message (Col. 6, lines 1-8).

As to Claim 19, **Bateman** teaches the system of claim 1 wherein:

the request message includes a callee user identifier (Col. 7, lines 9-11); and

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wherein the network telephony connection server determines the telephony identifier for the callee identified in the callee user identifier and sends the response message to the callee at the telephone identifier (Col. 7, lines 9-11).

As to Claim 21, **Bateman** teaches the method of Claim 20 further comprising the steps of:

sending at least one commercial message to the second data network telephone (Col. 17, lines 1-4).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 41-43, 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by **Gerszberg et al.** (US 6,226,362).

As to Claims 41, 45, with respect to Figures 4-6, **Gerszberg** teaches a commercial message server, 38, comprising:

at least one corporate (commercial) message for display on a video phone (voice communications device), 130 (Figures 1 and 5);

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a telephony server interface, 22, to receive connection information from a telephony connection server, 34, the connection information comprising at least one caller (user identifier) for at least one party to a telephone call (Col. 8, lines 60-65),

the at least one party using the voice communications device to initiate the telephone call (Col. 8, lines 60-65);

the commercial message server, 36, being operable to download the commercial message to the voice communications device in use by the at least one party identified by the user identifier prior to communicating voice signals to the voice communications device (Col. 10, lines 6-11 and Col. 9, lines 1-6).

As to Claims 42-43, **Gerszberg** teaches the commercial message server of Claim 41 wherein the commercial message server is operable to send the commercial message to the user identifier by sending the commercial message to the telephony connection server (Figure 1 and Col. 8, lines 60-65).

As to Claim 46, **Gerzberg** teaches the commercial message server of Claim 45 wherein the commercial message database includes merchant account information to maintain commercial messages and billing information for merchants (Col. 5, lines 25-26,39-46 and Col. 12, lines 26-27).

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*Response to Arguments*

7. Applicant's arguments filed in the 6/17/04 Remarks have been fully considered but they are not persuasive because of the following:

(a) With respect to the 35 USC 103 rejections, Examiner respectfully disagrees for the following reasons:

Col. 7, lines 1-5 and Figure 3, teach the process of viewing a HTML page (commercial message) before receiving voice information. In Figure 3, label 3.2, the customer is viewing product information. Labels 3.5 and 3.6 teaches the setting up a voice over IP call with the customer to obtain more information. The argument that a customer must first establish a call to the server system is also not persuasive. This is because the disclosure teaches that commercial messages are transmitted to data phones during conversations or while a call is being set up (Page 15, lines 10-15, line 29 through Page 16, line 1). Examiner respectfully believes that both **Bateman** and **Bannister** are in analogous art and it would have been obvious to combine the art to achieve the claims for the same reasons given in the instant office action.

(b) With respect to the 35 USC 102 rejections, Examiner respectfully disagrees for the following reasons:

Col. 8, line 60 through Col. 9, line 10 and 40-47, teach the process of viewing a corporate message (commercial message) before a call is transferred to someone (receiving voice information). This passage teaches that a caller view the commercial message and selects an address of a called party for which to connect. The argument that a customer must first establish a call to the server system is also not persuasive. This is because the disclosure teaches that



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commercial messages are transmitted to data phones during conversations or while a call is being set up (Page 15, lines 10-15, line 29 through Page 16, line 1).

(c) Examiner respectfully invites Applicants to contact Examiner to discuss other possible amendments for overcoming the prior art of record.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Angles et al.** (US 5,933,811) teach delivering customized advertisements to callers.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any response to this final action should be mailed to:

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**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**

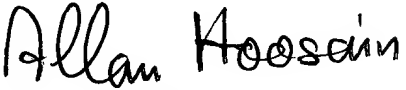
(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121  
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The  
examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
**Allan Hoosain**  
**Primary Examiner**  
7/20/04